

APPLICATION SERIAL NO.09/679,856
RESPONSE DATED 2/17/04
REPLY TO OFFICE ACTION DATED 11/18/03

ATTORNEY DOCKET NO. 37634.00000
MILBANK, TWEED, HADLEY & McCLOY LLP

REMARKS

The following issues are outstanding in the present application:

- Upon entry of the attached amendment, Claims 1-8, 10-26 and 53-63 will be pending;
- Original claims 1-54 were the subject of a restriction requirement;
- Original claims 27-52 were withdrawn from consideration by the Examiner;
- Original claims 1-2, 8, 25, 26, 53 and 54 were rejected under 35 U.S.C. § 102(e) as anticipated by Yamamoto et al. (U.S. Patent No. 6,150,027);
- Original claims 1, 2, 11, 12, 53, and 54 were rejected under 35 U.S.C. § 102(b) as anticipated by Huston et al. (U.S. Patent 5, 585,640);
- Original claims 2-6 were rejected under 35 U.S.C. § 103(a) as obvious in view of Yamamoto et al. (U.S. Patent No. 6, 150,027);
- Original claims 13-26 were indicated as allowable over the prior art of record; and
- Original claims 7, 9 and 10 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Telephone Interview

Applicants acknowledge with appreciation the courtesy of the Examiner's telephone call of November 14, 2003 regarding the restriction requirement. During the telephone conversation, the undersigned counsel provisionally elected claims 1-26 and 53-54 with traverse.

APPLICATION SERIAL NO.09/679,856
RESPONSE DATED 2/17/04
REPLY TO OFFICE ACTION DATED 11/18/03

ATTORNEY DOCKET NO. 37634.00000
MILBANK, TWEED, HADLEY & McCLOY LLP

Restriction

The Examiner has made the Restriction Requirement final. Applicants hereby cancel claims 27-52. Applicants reserve the right to present claims directed to the non-elected inventions in a divisional application, which shall be subject to the prohibition of the third sentence of 35 U.S.C. § 121 against the use of a "[a] patent issuing on an application with respect to which a requirement for restriction under this section has been made ... as a reference ... against a divisional application."¹

Amendments

An amendment has been made to the specification at page 8 to correct a typographical error.

Claims 1, 2, 8, 25, 26, 53 and 54 were rejected under 35 U.S.C. § 102(a) as anticipated by Yamamoto et al (U.S. Patent No. 6,150,027). Claims 1, 2, 11, 12, 53 and 54 were rejected under 35 U.S.C. § 102(b) as being anticipated by Huston et al. (U.S. Patent No. 5,585,640). In addition, claims 2-6 were rejected under 35 U.S.C. § 103(a) in view of Yamamoto et al.

The Examiner has indicated that claims 13-26 are allowable over the prior art of record, and that claims 7, 9 and 10 contain subject matter that would be allowable if the claims were to be rewritten in independent form. Applicants understand from their analysis of the Examiner's actions that the prior art does not teach a composite comprising a body of glass having embedded therein a plurality of nanoparticles, at least some of which are comprised of rare earth iron garnet, including in particular, yttrium-iron-garnet. Applicants agree with the Examiner's

¹ 35 U.S.C. §121. See also M.P.E.P. §804.01.

APPLICATION SERIAL NO. 09/679,856
RESPONSE DATED 2/17/04
REPLY TO OFFICE ACTION DATED 11/18/03

ATTORNEY DOCKET NO. 37634.00000
MILBANK, TWEED, HADLEY & McCLOY LLP

assessment of the prior art. Accordingly, the rejected independent claims (claims 1 and 53) have been amended to include the limitation that at least certain of the nanoparticles embedded in said body are comprised of rare earth iron-garnet. Neither Yamamoto et al. nor Huston et al. suggest embedding such nanoparticles in a body of glass. In addition, applicants have made other minor amendments to originally presented claims 1-26 and 53-54. These include an amendment to correct the dependency of claim 4. Applicants have also amended claims 3, 5, 6, 16, 18 and 19 to add the word "about" when describing the ranges being claimed. Use of the term "about" in connection with these ranges is supported in the specification, for example, at page 11, lines 11-19. Applicants have also amended claims 8, 10 and 22 to clarify that the claimed subject matter includes composites with nanoparticles that may also comprise nanocrystals. Support for these amendments is found in the original claims as filed, and also in the specification at page 10, line 30 to page 11, line 3.

Accordingly, Applicants believe that claims 1-26 and 53-54 as amended are now in condition for allowance, and a speedy indication of allowance is hereby respectfully requested.

In addition, Applicants have presented new claims 55-63, which are directed to a composite body formed by a process of enumerated steps. Such a claim is directed to a product. See M.P.E.P. §2113 ("[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself."). As such, Applicants do not believe that presentation of such claims is contrary to the Examiner's restriction requirement because such claims are not directed to "a method of forming a composite," which is the non-elected subject matter. Moreover, independent claim 55, on which claims 56-63 depend, includes the limitation, in conjunction with the other limitations of the claim, that the

APPLICATION SERIAL NO.09/679,856
RESPONSE DATED 2/17/04
REPLY TO OFFICE ACTION DATED 11/18/03

ATTORNEY DOCKET NO. 37634.00000
MILBANK, TWEED, HADLEY & McCLOY LLP

nanoparticles are comprised of rare earth iron garnet. For that reason, the prior art does not teach the inventions claimed in claims 55-63.

Accordingly, Applicants believe that new claims 55-63 are also in condition for allowance, and a speedy indication of allowance is hereby respectfully requested.

CONCLUSION

This application is now in condition for allowance. Should the Examiner have any questions, comments or suggestions in furtherance on the prosecution of this application, he is invited to contact Applicants' representative by telephone at the number indicated below. If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 13-3250, reference No. 37634.0000.

Respectfully submitted,

Dated: February 17, 2004


Jay I. Alexander (Reg. No. 32,678)

Milbank, Tweed, Hadley & McCloy LLP
International Square Building
1825 Eye Street, N.W., Suite 1100
Washington, D.C. 20006
Telephone: (202) 835-7591
Facsimile: (202) 835-7586